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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
08/509,359	07/31/95	ST. GEORGE-HYSLOP	P CAN-204
			EXAMINER
PATENT ADMINISTRATOR TESTA HURWITZ & THINEAULT HIGH STREET TOWER 125 HIGH STREET BOSTON MA 02110			1819
			DATE MAILED: 07/21/97

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

#### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 10-12, 14, 24, 25, & 69-72 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 10-12, 14, 24, 25 & 69-72 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

Claims 10-12, 14, 24, 25, and 69-72 are now in the application.

Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 10-12, 14, 69, and 70 drawn to an isolated nucleic acid coding for E5-1 protein, and an isolated nucleic acid sequence complementary to one coding for E5-1 protein, classified in Class 536, subclass 23.5, for example.

II. Claims 24, 25, 71, and 72, drawn to an isolated E5-1 protein, classified in Class 530, subclass 350, for example.

The inventions are distinct, each from the other, because of the following reasons:

The isolated DNA molecules of Invention I are products which are materially different and patentably distinct from the isolated proteins of Invention II. Methods for making and using the DNA molecules of Invention I require technologies and search of a body of prior art that are distinctly different from those required to make and use the proteins of Invention II.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art due to their divergent subject matter and as shown by their separate classification, and because the search required for each of Groups I and II is not required for the other Group, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least

one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

General Information Regarding Further Correspondence

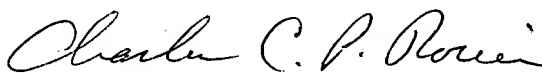
Any inquiry concerning this or earlier communications from the examiner should be directed to Dr. Charles Rories, Group 1800, Art Unit 1819, at telephone number (703)-308-1120. The examiner can normally be reached on Monday-Thursday from 7:30 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached at (703)-308-2035.

Papers related to this application may be submitted to Art Unit 1819 in Crystal Mall I by facsimile transmission to telephone number (703)-308-0294. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application, should be directed to the Group 1800 receptionist, at telephone number (703)-308-0196.

3/18/97

  
Charles C. P. Rories  
Patent Examiner  
Art Unit 1819